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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,853	07/24/2001	Susumu Kobayashi	2001_1035A	4034

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EXAMINER

TANG, KAREN C

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,853

Applicant(s)

KOBAYASHI ET AL.

Examiner

Karen C. Tang

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/24/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/14/02, 9/5/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-7, 9-11, 13-15, 17, 18, 20-22, 24-26, 28-30, 32-34, 36, 37, 39-41, 43-45, 47, 48, 50-52, 54-56, 58 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuzma (US 5,781,901).

1. Referring to Claims 1, 5, 9, 13, 17, 20, 24, 28, 32, 36, 39, 43, 47, 50, 54, and 58, Kuzma indicates an e-mail transmission/reception system including a mail terminal (user, 532, refer to Col 8, Lines 10-30), a mail server (505, refer to Col 8, Lines 1-10), and a mail gateway (HTTP server, refer to Col 4, Lines 40-60), wherein the mail gateway is connected to the mail terminal via a network (HTTP server is within the PC/user, refer to Col 4, Lines 40-60) and the mail server via another network (501, refer to Fig 5),

the mail server comprising:

an attached file (post office server consists of storing ability to store attachment, refer to Col 5, Lines 25-30) holding unit operable to receive email addressed to a user (multiple users, when sending emails to destinations, it is inherent that the email addressed is required, refer to Col 2, Lines 20-55, and Col 5, Lines 25-40) who possesses the mail terminal (PCs 211, 212, refer to Col 5, Lines 25-40) and hold one or more attached files (refer to Col 7, Lines 30-45) included in the email; and

Art Unit: 2151

a mail distribution unit operable to receive e-mail transmitted from the mail gateway and distribute the e-mail to one or more receivers address thereof (it is inherent that the distribution unit is within the system because the mail/attachment are distributed to the receiver's address therefore., refer to Col 5, Lines 25-40),

the mail gateway comprising:

an identifier generation unit operable to generate an identifier for each attached file held by the attached file holding unit (attachment reference 402, is generated, refer to Col 5, Lines 50-67);

a list transmission unit operable to generate a list of identifiers generated by the identifier generation unit and transmit the list to the mail terminal (transmit the references across Internet, refer to Col 5, Lines 55-67).

A reception unit operable to receive e-mail transmitted from the mail terminal, the e-mail including one or more identifier (plurality of references, refer to Col 7, Lines 30-45) that the user selects from the identifier list as substitutes for one or more attached files that the users wants to attach (it is inherent that the user can select the references/attachment to be attached with the e-mail) to the e-mail (application program which is able to retrieve attachment using the references within the email, refer to Col 6, Lines 30-50);

An attached file acquisition unit operable to acquire attached files from the attached file holding unit, the attached files corresponding to the identifiers included in the e-mail received by the reception unit (refer to Col 6, Lines 14-30 and Lines 40-60);

Art Unit: 2151

A construction unit operable to construct e-mail by attaching the attached files acquired by the attached file acquisition unit to the e-mail received by the reception unit; and (e-mail created by the PC 210, sent to the PC 212 and 211, and sent along with the reference attachment to the destination, refer to Col 5, Lines 25-45)

A mail transmission unit operable to transmit the e-mail constructed by the construction unit to the mail server (email transmit to the server, it is inherent that before transmit email to the server, the email has already constructed with the attachment reference sent to the user, refer to Col 5, Lines 25-40 and Col 6, Lines 40-60),

The mail terminal comprising:

A list of reception unit operable to receive the identifier list from the mail gateway (refer to Col 6, Lines 30-60);

A preparation unit operable to prepare e-mail that includes one or more identifiers (plurality of references, refer to Col 7, Lines 30-45) selected by the user from the identifier list (refer to Col 3, Lines 30-45) as substitutes for one or more attached files (attached reference is not the actual file, but a reference to point to the actual location of the file) that the user wants to attach to the e-mail; and

A transmission unit operable to transmit the prepared e-mail to the mail gateway (email transmit refer to Col 7, Lines 45-67, and Col 8, Lines 1-30);

2. Referring to Claims 2, 6, 10, 14, 21, 25, 29, 33, 40, 44, 51, and 55, Kuzma discloses the e-mail transmission/reception system wherein,

Art Unit: 2151

the attached file holding unit (server consists of a holding unit to store attachment/emails, refer to Col 3, Lines 15-35), whenever receiving e-mail that includes attached files (refer to Col 3, Lines 15-45), generates a list of the attached files and passes the list to the identifier generation unit (shown how the attached files transferred to the identifier/references, refer to Col 5, Lines 25-67, shown how plurality of files can be utilized and transmitted, Col 7, Lines 30-45 and how the files are transmit from the server/505 to the gateway/535, refer to Col 7, Lines 45-67 and Col 8, Lines 1-10 and how the server convert the file to the reference, refer to Col 8, Lines 29-46), and the identifier generating unit generates an identifier for each of the attached files in accordance with the list passed by the attached file holding unit (refer to 5, Lines 45-67).

3. Referring to Claims 3, 7, 11, 15, 18, 22, 26, 30, 34, 37, 41, 45, 48, 52, 56 and 59, Kuzma discloses the e-mail transmission/reception system of Claim 1, wherein the mail terminal further comprises:

a file format registration unit (which store/register the message in the encrypted format, refer to Col 7, Lines) operable to register one or more files formats of attached files for each receiver's address that the receiver should adopt in the mail gateway (the encryption key is transmitted via network and would be received at the subnet/gateway 536, refer to Col 7, Lines 45-67, and the receiver would utilized the receiving message/decryption key, to unlock the message, refer to Col 7, Lines 10-31),

The mail gateway further comprises:

Art Unit: 2151

A file format storage unit operable to store receivers' addresses and file formats that are registered by the file format registration unit (www http server consists a storage unit which stores attachment, refer to Col 5, Lines 45-67, and the attachment reference also indicates how the attachment file is to be compressed/encrypted/file format, and URL, which is generated within the attachment reference, provides the address of where the file is, refer to Col 6, Lines 1-30); and

A file format conversion unit operable to convert file formats of attached files for each receiver's address in accordance with the receivers' address and the file formats that are stored in the file format storage unit (application program can retrieve/decrypted/decompressed/convert the attachment utilizing the references, refer to Col 6, Lines 30-60),

Wherein the construction unit constructs e-mail by attaching the attached files converted by the file format conversion unit from and as a substitute for the attached files acquired by the attached file acquisition unit (e-mail created by the PC 210, sent to the PC 212 and 211, and sent along with the reference attachment to the destination, refer to Col 5, Lines 25-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2151

Claims 4, 8, 12, 16, 19, 23, 27, 31, 35, 38, 42, 46, 49, 57, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma (US 5,781,901) in view of Okada et al hereinafter Okada (US 6,836,891).

1. Referring to Claim 4, 8, 12, 16, 19, 23, 27, 31, 35, 38, 42, 46, 49, 53, 57, and 60,

Kuzma indicates the e-mail transmission/reception system wherein,

the mail terminal (user, 532, refer to Col 8, Lines 10-30) further comprises:

the mail gateway that one or more attached file included in e-mail addressed to the user of the mail terminal are to be shared with other users (multiple of attachments can be sent, refer to Col 7, Lines 30-45 and sent to multiple end users, refer to Col 5, Lines 25-30, thus, it is inherent that the files can be shared among users),

the mail gateway further comprises (WWW HTTP server, refer to Col 6, Lines 30-60):

an attached file sharing unit operable to, the attached files are to be shared with the other users from the mail terminal, share each of the attached files held by the attached file holding unit with the other users (end user consists of a post office server, which can store information, refer to Col 5, Lines 25-45, and multiple of attachments can be sent, refer to Col 7, Lines 30-45 and sent to multiple end users, refer to Col 5, Lines 25-30, thus, it is inherent that the files can be shared among users);

the attached file shared by the attached file sharing unit (multiple of attachments can be sent, refer to Col 7, Lines 30-45 and sent to multiple end users, refer to Col 5, Lines 25-30, thus, it is inherent that the files can be shared among users), wherein the shared

Art Unit: 2151

identifier is available for sharers of the attached files (attachment references, which generated per reference, refer to Col 5, lines 45-67),

the mail gateway of one or more identifiers selected by the user from the identifier list as substitutes for the one or more attached files that are permitted to be shared (user can select the attachment(s)/identifier/references to be sent, refer to Col 3, Lines 15-45 and can be sent to multiple users); and

the mail gateway of one or more sharers of each of the attached files that are to be shared with the other users (multiple of attachments can be sent, refer to Col 7, Lines 30-45 and sent to multiple end users, refer to Col 5, Lines 25-30, thus, it is inherent that the files can be shared among users),;

wherein the attached file sharing unit shares (there can be multiple references/identifiers to be sent, refer to Col 7, Lines 30-45) attached files that correspond to the identifiers attached files held by the attached file holding unit (HTTP server can also store attachment files, refer to Col 7, Lines 10-31) with the sharers (multiple end users, refer to Col 5, Lines 25-27),

the list transmission unit further transmits a list of the attached files (refer to Col 7, Lines 30-45), and

the list reception unit further receives a list of shared identifiers (when sent out to multiple recipients, the attachment reference became shared) that have one to one

Art Unit: 2151

correspondence to each of the attached files that are shared by the user of the mail terminal as one member of the sharers (refer to Col 5, Lines 25-60).

Kuzma does not expressly indicate the shared notification

Okada indicate the shared notification when the file is being shared (refer to Col 14, Lines 45-67 and Col 15, Lines 1-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to implement a notification when files are being shared among users.

The suggestion/motivation for doing so would have been that the user monitors any update when a message is being transmitted via network especially if any files are being attached or shared with other users.

Conclusion

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2151

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KT


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER